

PATENT
Docket 23FLC31

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EXPEDITED PROCEDURE
ART UNIT 3643**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**Applicant:
F.L. Conte

Art Unit: 3643

Application No.: 10/643,288
Confirmation No: 4031

Examiner: Rowan, K.

Filed: 08/20/2003

Title: Duplex Lash Insect Swatter

RESPONSEMail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the office action dated as mailed on 12/17/04, and having a period of response extending through and including 03/17/05, Applicant requests reconsideration.

Applicant traverses the rejection of claim 17 under 35 USC 112, first paragraph.

Claim 17 was modeled after claim 1, and recites in more particularity the figure eight lash 34 with first and second knot-less loops 18a,b at opposite ends of the two bands 36,38, with a knot 40 therebetween.

This species of the swatter recited in claim 17 is illustrated in Figures 5 and 6, and operates in the same manner shown in Figure 1.

This species of the swatter is also described at paras.

CERTIFICATE OF TRANSMISSION (37 CFR 1.8a and MPEP 512)

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FRANCIS L. CONTE

(Name of person transmitting paper)



(Signature of person transmitting paper)

8 Feb 2005

(Date)

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19,57,60,61,65 of the specification, for example.

Accordingly, the subject matter of this claim is clearly shown in the Figures, and described in the specification, and well meets Section 112, first para.; and the examiner has not shown otherwise, nor explained any problem with the claim as written.

It is noted that claim 17 is an apparatus claim, and is not a method claim, and therefore no method-of-use needs reciting in this claim.

As for how the insect swatter is in fact used, the specification well explains this method of use, and the examiner's question of use is not understood since the examiner has now been prosecuting the parent application for over a decade, and now prosecutes this improvement application, and it should well be apparent that the recited lash is used as a whip to whip insects, as the specification so explains in considerable detail.

Figure 6 clearly shows the lash 36 stretched on the gun in the same manner shown in figures 1-4, and release of the distal end of the lash unleashes the energy stored therein to propel the lash forward as shown in Figure 1 to strike the insect.

The examiner's mere statement that the "elastic lash is used to launch the elongate rod" is a facetious example, with no support in the specification or the figures.

The examiner's mere statement that the "rod is swung to kill insects with the elastic lash" is another facetious example, with no support in the specification or the figures.

And, the examiner's last example that "the elongate rod is used to launch the lash and if so how" better conforms with the specification, although the examiner's failure to afford due weight to that specification is perplexing.

If the description in the specification and the illustration in the drawings are still deemed insufficient by the examiner, he is requested to explain why to clarify the issues for appeal, see MPEP 2164.01(c).

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Accordingly, withdrawal of the rejection of claim 17 under 35 USC 112, first paragraph, is warranted and is requested.

Applicant traverses the repeated rejection of claims 1-4 and the new rejection of claim 17 under Section 103(a) over Kopp.

The examiner has merely repeated the previous rejection; and therefore Applicant repeats the previous traverse.

The examiner's use of Harza again fails to apply that case based on the facts thereof, and is therefore an impermissible use of the holdings thereof.

In para. 5 of the office action the examiner uses examiner argument to merely contend why Harza is applicable, but examiner argument is never evidence.

The examiner has clearly failed to identify the facts of Harza, and apply the holdings thereof as required to invoke case law in support of the rejection.

The examiner is not permitted to re-define the facts or holdings of Harza as he sees fit to supplant the learned CCPA's opinion to reject the claims: this would present an impossible burden for applicants before the USPTO.

The examiner merely opines that "Harza suggest[s] employing more than one of an item for multiplied effect." However, this is mere examiner argument, and the examiner has failed to identify any specific statement or holding in Harza to this effect.

Harza applies to the mere duplication of parts (MPEP 2144.04) under the fact pattern thereof. This holding does not support the examiner's mere argument, and the examiner has not shown otherwise.

The examiner again provides mere examiner argument that "This would encompass both having two rubber bands side by side and two rubber bands connected lengthwise...." The examiner then provides his mere opinion of advantages, with the bald conclusion that "This is the nexus between the art of record, the case law and the claims of the present invention."

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However, the examiner has yet again failed to apply Harza under the facts thereof and under the specific holdings; which are very narrow to the mere duplication of parts.

The examiner is respectfully requested to re-read the Harza case, it is quite short, and notice that although claim 1 was rejected for "mere duplication of parts", claims 7 & 10 were not, nor are they mentioned in MPEP 2144.04.

Indeed, by the mere addition of an apparently minor geometric variation in otherwise duplication of parts, the CCPA found claims 7 & 10 patentably distinguishable over the same reference.

The present examiner is clearly using a subjective interpretation of the rote holding of Harza as found in the MPEP summary thereof, without regard to the specific facts of that case itself, and without regard to the express holdings; which holdings include finding patentably distinguishable features where duplication of parts is found, as long as some other difference is found in the claims.

The present examiner clearly fails to afford any weight to the claim language; now, and for the last decade in the parent application.

Applicant's insect swatter invention may be simple, but so was the water stop invention in Harza, which case is being used by the examiner not for what it fairly teaches, but as a mere vehicle in the MPEP reference thereto for the examiner to make unwarranted extensions thereof to deny Applicant the fair and objective evaluation of his claims over the relevant case law.

This examiner clearly would not have allowed claims 7 & 10 in the Harza case based on the simple differences therein; yet the CCPA did.

At best, Harza might suggest that two or more of the toy guns of Kopp might be merely duplicated and used side-by-side.

Perhaps, even two or more of the bands 5 might be duplicated and used side-by-side with corresponding duplicated trigger mechanisms.

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But, even such duplicated parts in Kopp does not appear supported by Harza, and the examiner has not shown otherwise. There are just too many changes required in Kopp in addition to duplicating parts therein, and the examiner has not shown otherwise.

Any change in Kopp, other than the mere duplication of parts would appear patentably distinguishable based on a more careful review of Harza.

The examiner's mere contention that "two rubber bands side by side and two rubber bands connected lengthwise" have advantages is bald hindsight without any basis in Kopp or Harza.

If the two bands were joined lengthwise in Kopp, would the stock 2 have to be twice as long? Or, would those two bands have to be half as long for the same size stock? And, how would those special bands with end knots 6 be joined together?

These are clearly relevant changes required to modify Kopp as the examiner contends; yet Harza clearly holds that even a minor geometrical change in the apparatus was sufficient to find the claim patentably distinguishable.

The present examiner is interpreting Harza not for what it fairly, and narrowly, holds, but for what the examiner would like Harza to hold to uphold his insupportable rejection.

The examiner has been twice overturned on appeal to the Board in the parent case, and continues quite strenuously to reject the present improvement claims without regard to the novelty in the parent application as found twice by the Board of Appeals, and without regard to the novelty and advantages of the present claims.

On page 6 the examiner merely opines that "Applicant has not submitted any evidence that one rubber band functions any different than two or more rubber bands to replace one longer one." What does this mean? And, how is this relevant to the claims, Kopp, and Harza?

The examiner has the burden to show by evidence that Kopp

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would have been modified by one skilled in the art, yet he has not met this burden.

The examiner has the burden to apply the holding of Harza objectively based on the facts thereof, and the examiner clearly has not.

In Kopp, a single band is used because only a single band can be installed on the stock as disclosed by Kopp. Why add multiple bands to Kopp? The examiner cannot use Applicant's claims as the guide. The examiner cannot turn the burden upside down, and require the Applicant to provide evidence of the negative.

In Harza, plural water stop features were found a mere duplication of parts in claim 1, but in claims 7 & 10 the plural water stop features were not found mere duplication of parts since these claims also recited a simple geometric variation.

In Applicant's claim 1, two annular bands are joined in series for specific benefit. In Kopp, a single strand band is used, and is not annular. Nevertheless, the examiner challenges Applicant as not submitting evidence regarding the number of bands?

To the contrary, paras. 62 et seq explain the substantial improvement of two bands in series as opposed to two bands in parallel. Spring rates or stiffness are fundamental features of mechanical design, and the series or parallel use thereof is clearly quite different, and the examiner has not afforded any weight to this difference.

Springs are fundamental elements of mechanical systems and have system counterparts in electrical circuits. And, in electrical circuits fundamental elements include resistors, for example, which also may be joined in series and parallel for different effect.

The issue is not the simplicity of a spring or a resistor, but how they are joined together in combination, and the function and advantages of the combination.

Just as resistors, capacitors, and transistors, may be

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simply duplicated and joined together on a printed circuit board in novel combinations in series or in parallel to effect a myriad of different functions and purposes, so too may springs and other mechanical parts be duplicated and joined together in myriad combinations for different functions and purposes.

Applicant's claims recite a special combination of bands in series for special purpose to solve special problems in an improvement application over the parent application, already found allowable by the Board of Appeals over the various rejections of the examiner. It is conspicuous that the examiner has not uncovered a single additional reference relevant to the new combinations now being claimed.

Instead the examiner is using the expedient of case law holdings found in brief extract in the MPEP, without apparent regard to the entirety of that case law, without regard to the facts of that case law, and without regard to the multiple holdings thereof which also apply to the non-obviousness of the claims when studied thoroughly and when applied objectively as intended; not applied subjectively in a vacuum as apparent from the examiner's bald remarks.

The examiner overlooks the specific features of the claims and the specific features of Kopp and the specific facts and holdings of Harza to deny Applicant claims to which he is entitled over the same art of record now being applied from the parent application in this decade long odyssey.

The examiner's reference to McLaughlin is mere rote repetition from form paragraphs of the MPEP, and overlooks the fundamental errors in applying Kopp and Harza, and only compounds the errors of the rejection.

The examiner's reference to Keller is again mere rote repetition from form paragraphs of the MPEP, and overlooks the fundamental errors in applying Kopp and Harza, and only compounds the errors of the rejection.

Indeed, the examiner's contention that "the test for obviousness is not whether the features of a secondary

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reference may be bodily incorporated into the structure of the primary reference," overlooks the fundamental rejection in para. 2 of the office action which uses a single reference, i.e. Kopp, not multiple references.

The examiner's fundamental basis for all the rejections is the use of Harza, which as indicated above clearly fails to support the examiner's use thereof, and to the contrary, the Harza case supports the patentable novelty of all the claims since the examiner has expressly failed to afford any weight to the clear differences recited in the claims which are much, much more than the mere duplication of parts.

Accordingly, the examiner has failed to establish even a prima facie rejection of claims 1-4, which clearly recite elements and cooperation thereof neither disclosed nor suggested by Kopp.

As for claim 17, the examiner has conspicuously overlooked this claim in the para. 2 rejection.

Kopp clearly discloses a knot 6 required for its operation, and claim 17 expressly excludes knots at both loop ends. There can be no mere duplication of parts here, nor obviousness, and the examiner has not shown otherwise in the rush to reject even new claim 17 without addressing the new features specifically recited in this claim.

Accordingly, withdrawal of the rejection of claims 1-4 and 17 under Section 103(a) over Kopp is warranted and is requested.

Applicant traverses the repeated rejection of claims 5-9, and the new rejection of claims 18-20 under Section 103(a) over Kopp and Watkins; and hereby incorporates by reference the previous rebuttal of the former.

Kopp discloses a single band 5 with a special knot 6 and a special trigger arrangement therefor and a special operation.

Watkins discloses a single band 14 with a special leather loop 16 and a special trigger arrangement therefor and a special operation to hurl projectiles.

The two references Kopp and Watkins could not be any more

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different, but the examiner affords no weight to such fundamental differences; instead choosing to use Applicant's claims as the guide and merely contend in hindsight that Applicant's claims would have been obvious "for the same reasons stated in the first Office Action."

However, the examiner has failed to traverse Applicant's rebuttal of this now twice repeated rejection; and para. 5 again relies on Harza, without due weight thereto, and the mere rote presentation of MPEP form paragraphs for McLaughlin and Keller, without regard to the present claims, without regard to the very teachings of those references, and without regard to the stringent requirements of the MPEP for supporting Section 103 rejections using legal motivation based on evidence.

Applicant has traversed each of claims 5-9 in the previous response, which is incorporated herein by reference.

Claims 18-20 were previously added, and the examiner has failed to address these claims one by one, and has therefore failed to establish even a prima facie showing.

Claim 18 depends from new claim 17 and recites the swatter including the figure eight lash with knot-less loops at opposite ends.

In Kopp, the band 5 has a knot 6 at its distal end, and is a single strand.

In Watkins, the band 14 is annular, with the leather pouch 16 at the string 37 end.

The examiner's contentions in para. 3 appear to be verbatim with those presented in the earlier rejection in para. 3, and lack any analysis of the novel features recited in claims 18-20.

The features listed in claim 18 above are clearly not disclosed or suggested by Kopp and Watkins, and the examiner has not shown otherwise; nor has the examiner explained any modifications of these disparate references for any reason, let alone legal motivation, for making such modifications.

Claim 19 recites the series configuration with the reciprocal spring rates having no counterpart in the applied

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references which show single bands.

Claim 20 recites the identical bands having no counterpart in Kopp and Watkins.

As indicated above, how would the different bands of Kopp and Watkins be combined in the first instance?

Which features from which bands would remain in the final band as used in Kopp?

And, where is the teaching of the size or configuration of the combined bands of these disparate references configured for different purposes?

The examiner's rejections fail to address these critical issues, and fail to meet the stringent requirements of the MPEP.

Accordingly, withdrawal of the rejection of claims 5-9 and 18-20 under Section 103(a) over Kopp and Watkins is warranted and is requested.

Applicant traverses the repeated rejection of claims 10-16 under Section 103(a) over Kopp, Watkins, and Stone.

The examiner's contentions are substantially verbatim in para. 4 as they were in para. 4 of the last office action.

And, Applicant incorporates by reference the previous traverse thereof.

The examiner's additional contentions in para. 5 are clearly an expedient having no disclosed relevance to the rejections of the specifically listed claims.

Harza, as explained above, is evidence of the non-obviousness of all of Applicant's claims in view of the substantial differences of the recited lash over the different bands of the applied references.

Those differences clearly undermine the examiner's attempt to apply Harza for the mere duplication of parts, when the claims recite much more than mere parts duplication, but different parts fundamentally, having different geometric features presenting even more differences than the minor geometric differences expressly contained in the Harza case for which the CCPA found the claims patentably distinguishable.

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The examiner has clearly failed to afford any weight to the series bands recited in the claims; has clearly failed to consider the whole of such claims and the problems being solved and the benefits disclosed in the specification; and has used mere hindsight to apply disparate references without regard to their own teachings, own problems, and different solutions.

The examiner's use of McLaughlin is conspicuous as a rote MPEP form paragraph, presenting mere examiner argument without regard to the facts. The "bodily incorporated" standard does not permit the examiner to disregard the differences of these references, or to disregard that the proposed combination would render inoperable Kopp for its intended purpose.

In Kopp, the band is contracted. In Watkins, the band is used to propel an projectile.

So, how would these two types of different bands be combined in Kopp? Why? And, would the combination be used to contract the two-band combination, or hurl a projectile?

"Bodily incorporated" is clearly mere examiner argument, without regard to the facts.

As for Keller, what are the combined teachings of Kopp and Watkins, which disclose two fundamentally different configurations for different purposes? Clearly, those combined teachings would not be Applicant's recited invention in its various species, and the examiner has not shown otherwise.

The examiner applies Harza, McLaughlin, and Keller for mere generalities since the examiner lacks evidence in the very references being applied now, and previously applied in the parent. The examiner applies the references and these cases out of context and without regard to the whole thereof.

The examiner's bald arguments are conspicuous in this regard, and fail to afford due weight to the teachings of these references and these cases pointing to clearly patentable combinations recited in these claims.

In the previous amendment, this Applicant implored the examiner to avoid further protracting the present application, yet to no avail.

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The record is quite clear: this examiner has held steadfast in refusing to allow claims pertaining to the insect swatter in the parent, and now in this improvement application.

This examiner has been reversed twice by the Board of Appeals, which has confirmed the continued errors being made by the examiner.

And, this examiner has not found any claim allowable, and has clearly prejudged this application in the rush to reject the claims, without due regard to the very features recited in the claims, and without regard to the specific traverse in the last amendment, and, it is expected, without regard to this additional traverse.

This examiner is a primary examiner of many, many years of experience, and the protracted prosecution of the parent, and now this application, suggests an apparent abuse of discretion. Not once has the examiner offered any suggestions to the Applicant for amending claims to overcome any subjective standard being used by the examiner in rejecting the claims.

The examiner's rejections of the claims in the parent have been reversed twice by the Board.

This response is being filed to afford the examiner one last opportunity to allow the claims, or present the rejections with suitable explanation for purposes of appeal.

Rule 104 mandates thorough study, thorough investigation, and completeness of examination. Should the examiner maintain the present rejections, please ensure that these mandates of Rule 104 are fully complied with so that the Board of Appeals can finally decide this matter, just as it did twice before.

It is quite unfortunate that the patent system permits the present type of protracted prosecution, with its attendant high cost in time and money to applicants; and the corresponding expenditure of time by the examiner, his supervisors for appeal, and the Board of Appeals, now twice, and most likely trice.

The examiner is the sole individual who may now use his considered experience and discretion to allow one or more

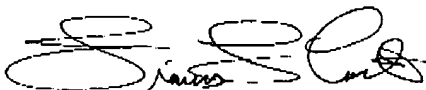
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claims over the references of record, or suggest any further amendments he believes would be warranted to better distinguish the claims over the references of record. If not, the Board will then have to decide.

In view of the above remarks, allowance of all claims 1-20 over the art of record is warranted and is requested.

Respectfully submitted,



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Date: 8 Feb 2005

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